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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/206,627	12/07/98	ALLEN A	30.1

EXAMINER	
PEREZ GUTIERREZ,R	
ART UNIT	PAPER NUMBER
2683	23

WM41/1010

HOWARD L. SPEIGHT
BAKER BOTTS L.L.P.
910 LOUISIANA
HOUSTON TX 77002

DATE MAILED: 10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.	Applicant(s)
09/206,627	Allen, Jr.
Examiner	**Art Unit**
Rafael Perez-Gutierrez	2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED *Sep 12, 2001* FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
 (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
 (b) ☐ they raise the issue of new matter. (See NOTE below);
 (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

 NOTE: _____
4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
 See attachment
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
 Claim(s) allowed: _____
 Claim(s) objected to: _____
 Claim(s) rejected: *1-11, 14, 16-22, and 24-33*
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ .
11. ☐ Other:

ATTACHMENT

1. This Advisory Action is in response to Applicant's after final amendment and remarks filed on September 12, 2001.

Response to Arguments

2. Applicant's arguments filed on September 12, 2001 have been fully considered but they are not persuasive.

In the present application, Applicant argues, on page 8 last two paragraphs of the remarks, that "claim 26 is anticipated only if it is inherent in Janky for the enable controller to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. This limitation is inherent in Janky only if the prior art in Janky necessarily includes the claimed limitations.". In support of these arguments, Applicant cited, from *Continental Can Co., U.S.A. v. Monsanto Co.,* 948 F.2d 1264, 1268, 20USPQ2d 1746 (Fed. Cir. 1991), that "[t]o serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.", and that "[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient."

The Examiner respectfully disagrees with Applicant's arguments because inherency can also be established "[i]f ... the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function", see *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20USPQ2d 1746 (Fed. Cir. 1991), which is exactly the case in the present application.

Janky et al. clearly disclose an embodiment in which the LDS receiver/processor (location-signal generating device) is kept in a "sleeper" mode to conserve power until the IS receiver receives and **responds to the specified IS** (abstract lines 18-20). Moreover, in the same embodiment, Janky et al. further disclose that LDS receiver/processor (location-signal generating device) is awakened by the controller (enable controller) only when a trigger event occurs (column 11 lines 31-40) and that the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver **only once** (column 12 lines 24-26).

Therefore, it is clear from this embodiment (i.e., power saving mode) of Janky et al. that the controller (enable controller), inherently, disables the LDS receiver/processor (location-signal generating device) and the IS responder/transmitter means 27 (telemetry transmitter) after the IS responder/transmitter means 27 (telemetry transmitter) transmits the location signal.

Additionally, Applicant's example, on page 9 first paragraph of the remarks, is clearly focusing in a variation of the above-mentioned embodiment which is not the one relying upon by the Examiner. As explained above, Janky et al. is clearly providing support for the inherent teaching (i.e., controller (enable controller) disabling the LDS receiver/processor (location-signal

generating device) and the IS responder/transmitter means 27 (telemetry transmitter) after the IS responder/transmitter means 27 (telemetry transmitter) transmits the location signal) when disclosing that the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver **only once**.

Applicant further provides the same arguments, as described above, for claims 1-11, 14, 16-22, 24, 25. However, the same arguments cannot be applied to said claims because they are more broader that claim 26. Claims 1-11, 14, 16-22, 24, 25 do not recite that the disabling, by the enable controller, is done after the location signal has been transmitted. Furthermore, even if said limitation was included in said claims, Janky et al. clearly meet that limitation as explained above.

Consequently, in view of the above reasons, and having addressed each of Applicant's arguments, the rejection is maintained by the Examiner.

Conclusion

3. Any response to this Office Action should be **faxed to** (703) 872-9314 **or mailed to**:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Hand-delivered responses should be brought to:

Crystal Park II
2021 Crystal Drive
Arlington, VA 22202
Sixth Floor (Receptionist)

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William G. Trost IV can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.

Rafael Perez-Gutierrez
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ PATENT EXAMINER
October 4, 2001

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600